

**Notice of Allowability**

Application No.

09/728,723

Examiner

ALEX NOGUEROLA

Applicant(s)

YENGOYAN ET AL.

Art Unit

1753

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 11/08/2005.
2. ☒ The allowed claim(s) is/are \_\_\_\_\_.
3. ☒ The drawings filed on 30 November 2000 are accepted by the Examiner.
4. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |   |   |
|---|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)  | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)           |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                | 6. <input type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),<br>Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment                   |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material          | 8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance             |
|   | 9. <input type="checkbox"/> Other _____   |

**DETAILED ACTION**

**EXAMINER'S AMENDMENT**

1. Underneath the title on page 1 of the specification the following has been inserted  
-- This application claims priority from provisional application 60/168,427, which was filed on November 30, 1999. --

***Allowable Subject Matter***

2. Claims 1-9, 11-15, 17-33, 35, 38-75, and 77-178 are allowed.
3. With respect to the expression "or derivative thereof" in the independent claims, although broad this limitation is not indefinite under 35 U.S.C. 112, second paragraph, as "breadth is not indefiniteness." MPEP 2173.04. Indeed, Applicants' have provided several examples of derivatives in the specification that would guide one with ordinary skill in the art as to what is encompassed by a derivative of a vinylogous carboxylic compound. See pages 10-11.
4. Applicants' arguments have resolved the rejection of various claims, under 35 U.S.C. 112, first paragraph, as being beyond the scope of enablement. Applicants have indicated, for

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example, that the specification states a necessary property for suitable vinylogous carboxylic compounds or derivatives thereof is for "mobilities that are comparable to the analytes of interest." See page 30 of the amendment of November 08, 2004. The specification also lists other necessary or desirable properties: "Their molar absorptivity is high. The transfer ratio can be higher (i.e.  $\text{SO}_4^{2-}$  to  $\text{PMA}^{4-}$ ). The absorbance noise is lower at higher wavelengths, and analyte interference is lower at the higher wavelength. Further, the problems of EOF precipitation are absent." See page 12 of the specification.

5. Applicants' specification states "vinylogous carboxylic acid compounds of the present invention are defined as compounds containing one or more enol functional groups in conjugation with one or more carbonyl functional groups through one or more carbon-carbon or carbon-nitrogen double bonds." See page 6, lines 14-20. The examiner agrees with Applicants that p-hydroxybenzoate, which is disclosed by Jones, is not a vinylogous carboxylic acid compound because it does not have conjugation between a hydroxyl group and a carbonyl group, but instead conjugation between a hydroxyl group and a carboxylic acid group. See the bottom of page 33 of amendment of November 08, 2004. Likewise, p-hydroxybenzoate is not a derivative of a vinylogous carboxylic acid compound because one with ordinary skill in the art would understand from the specification definition cited above of a vinylogous carboxylic acid compound, the Perez article cited on the same page as this definition, and the examples of derivatives shown on pages 10-11 that a derivative of a vinylogous carboxylic acid compound requires a carbonyl group in conjugation with a hydroxyl group that has been modified (such as to form an ester, as shown on the bottom of page 10 of the specification) or replaced (such as with

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an amine group, as shown on the top of page 11 of the specification), but still has conjugation between the modified or replaced hydroxyl group and the carbonyl group.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ALEX NOGUEROLA whose telephone number is (571) 272-1343. The examiner can normally be reached on M-F 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, NAM NGUYEN can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alex Noguerola  
Primary Examiner  
AU 1753  
January 19, 2005